Daniel T. Pascucci, Esq. (SBN 166780)
dpascucci@mintz.com
Nathan R. Hamler, Esq. (SBN 227765)
nhamler@mintz.com
MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC
3580 Carmel Mountain Road, Suite 300
San Diego, CA 92130
Telephone: (858) 314-1500
Facsimile: (858) 314-1501

Marvin S. Gittes, Esq. (*pro hac vice in case no. 3:07-cv-00893-IEG(NLS)*)
mgittes@mintz.com
Timur E. Slonim, Esq. (*pro hac vice in case no. 3:07-cv-00893-IEG(NLS)*)
tslonim@mintz.com
Peter F. Snell, Esq. (*pro hac vice in case no. 3:07-cv-00893-IEG(NLS)*)
psnell@mintz.com
MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC
666 Third Avenue
New York, NY 10017
Telephone: (212) 935-3000
Facsimile: (212) 983-3115

Attorneys for Defendant/Counter-Claimant
AMERICAN TECHNICAL CERAMICS CORP.

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

PRESIDIO COMPONENTS, INC.,

Plaintiff,

v.

AMERICAN TECHNICAL CERAMICS CORP.,

Defendant.

AMERICAN TECHNICAL CERAMICS CORP.,

Counter-Claimant,

v.

PRESIDIO COMPONENTS, INC.,

Counter-Defendant.

Case No. 3:08-cv-00335-IEG-NLS

ATC'S STATEMENT OF UNDISPUTED MATERIAL FACTS IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT OF INDEFINITENESS

ORAL ARGUMENT REQUESTED

Hearing Date: July 25, 2008
Hearing Time: 10:00 am
Courtroom 1

Defendant American Technical Ceramics Corp. ("ATC") hereby sets forth the undisputed material facts in support of ATC's Motion for Summary Judgment of Indefiniteness.

1. Presidio Components, Inc. ("Presidio") has asserted that claims 1-5, 16, 18 and 19 ("asserted claims") of U.S. Patent No. 6,516,356 ("the '356 patent") are infringed by ATC's 545L capacitor.

2. Claim 1 is an independent claim.

3. Claims 2-5, 16, 18 and 19 depend from, and thus incorporate all the limitations of, claim 1.

4. The '356 patent claims priority to and is a continuation-in-part of U.S. Patent Application No. 10/150,202, filed on May 17, 2002, now U.S. Patent No. 6,587,327 (the "Priority Application").

"Substantially Monolithic" Dielectric Body

5. All of the asserted claims of the '356 patent require "a substantially monolithic dielectric body."

6. The '356 patent does not expressly define "a substantially monolithic dielectric body."

7. There is no test in the technical literature or elsewhere to determine whether a dielectric body is substantially monolithic. (Transcript of Dr. Godhshalk's deposition taken on March 17, 2008 ("Tr.") 253:10-18.) The '356 patent specification also does not disclose such a test.

8. The claim term "a substantially monolithic dielectric body" is mentioned only twice in the '356 patent specification:

> The capacitor of the present invention is an integrated array of capacitors connected in series and/or parallel circuits in a *substantially monolithic dielectric body*. ('356 patent, col. 4, ll. 29-31.)
>
> * * *
>
> the capacitor has a *substantially monolithic dielectric body* formed from a plurality of ceramic tape layers laminated together in a green ceramic state and fired to form a sintered or fused monolithic ceramic structure. ('356 patent, col. 4, ll. 61-65.)

9. The specification of the Priority Application does not mention "a substantially monolithic dielectric body."

10. There are no degrees of "monolithicness" known to a person having ordinary skill in the relevant art of the '356 patent. (Rule 4.2 Statement of Dr. Joseph P. Dougherty In Support of ATC's Claim Constructions ("Dougherty") ¶ 27.)

11. Presidio's proffered expert, Dr. Edward M. Godshalk, states that the capacitor shown in Figure 8A of the '356 patent is "non substantially monolithic" within the meaning of claim 1 but could not determine whether a modified Figure 8A, shown below, would be "substantially monolithic" within the meaning of claim 1 because "[t]hat's so subjective. I can't answer that one." (Tr. 247:10-12, 248:1-8, 248:22-23.)

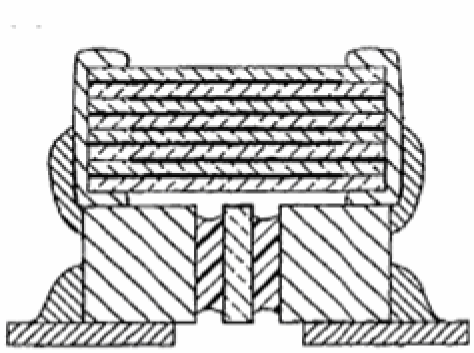
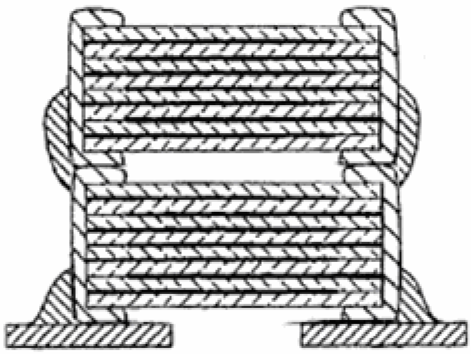


Figure 8A



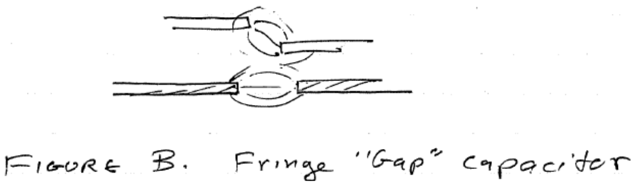
Modified Figure 8A

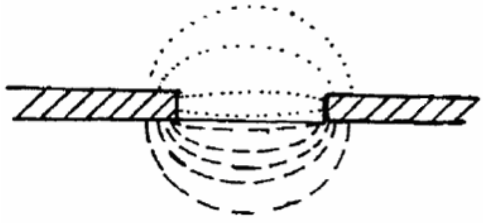
"Sufficiently Close" Contacts

12. All of the asserted claims of the '356 patent require "a conductive first contact …" and "a conductive second contact …," and further require "the second contact being located sufficiently close to the first contact to form a first fringe-effect capacitance with the first contact."

13. Capacitance is measured in farads, which is symbolized F.

14. According to the laws of physics, fringe-effect capacitance is always present wherever two electrical conductors are positioned in an edge-to-edge relationship, as depicted below:





(Tr. 100:17-21, 107:11-17, Ex. 6; Dougherty ¶ 15.)

15. The requirement in claim 1 for the first and second contacts to be "located sufficiently close" describes a spatial relationship. (Pres. Markman Br. at 12.)

16. According to the '356 patent specification, different fringe-effect capacitances are created by adjusting the gap width between the ends of contacts 12 and 13:

> *the gap* between … [the ends] 97 and 98, 108 and 109, 117 and 118 [of contacts 12 and 13 in Figures 18A and 19A]… *and the fringe capacitances created thereby*. ('356 patent, col. 12, ll. 18-20.)

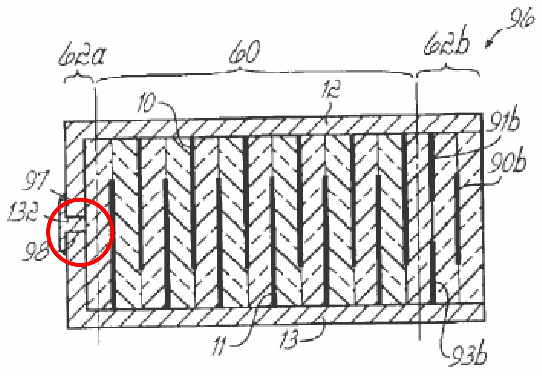


FIG. 18A

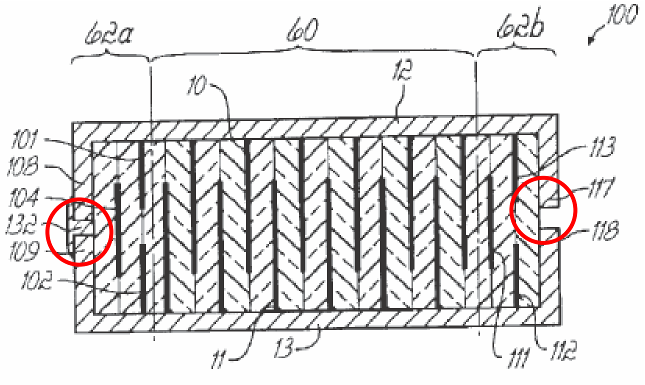


FIG. 19A

17. Generally, the closer the edges of the contacts 12 and 13, the bigger the resulting fringe-effect capacitance.

18. The '356 patent specification does not provide any numerical values of the gap widths between contacts 12 and 13 for any of the capacitors shown in the figures or described in the specification of the '356 patent.

19. The '356 patent specification does not provide any numerical values of the fringe-effect capacitances between contacts 12 and 13 for any of the capacitors shown in the figures or described in the specification of the '356 patent.

20. Presidio alleges that the claim term "the second contact being located sufficiently close to the first contact to form a first fringe-effect capacitance with the first contact" is the "novel aspect" and "central idea" of the asserted claims. (Tr. 124:8-11; 138:4-8; 139:11-140:2; 144:14-19; 145:3-16.) All other elements of claim 1 are present in the prior art.

21. The capacitors shown in Figures 18A and 19A of the '356 patent have contacts 12 and 13 "located sufficiently close … to form … fringe-effect capacitance" as claimed in claim 1. ('356 patent, 10:66-11:3 and 11:31-35.) The '356 patent does not provide numerical values for the spacing or the fringe-effect capacitance between contacts 12 and 13 in Figures 18A and 19A.

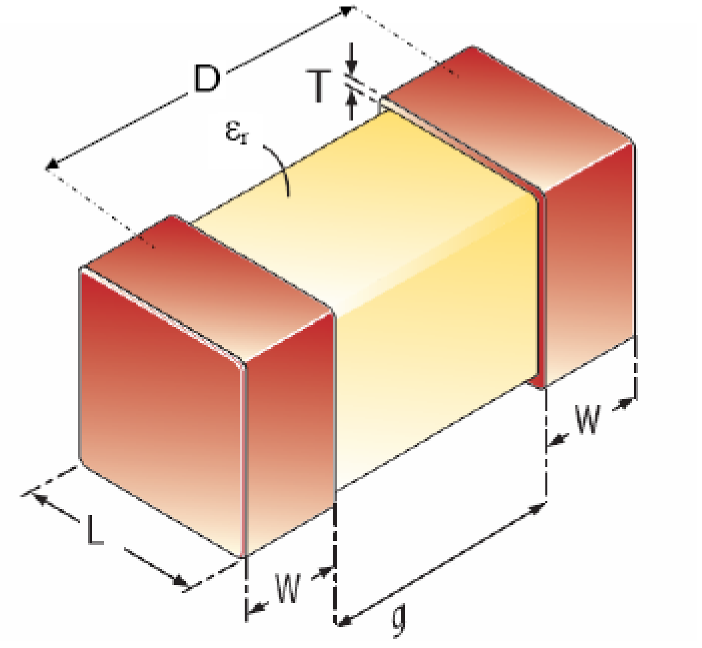
22. According to the '356 patent, the capacitor shown in Figure 2A does not have contacts 12 and 13 located "sufficiently close … to form … fringe-effect capacitance" as claimed in claim 1. The '356 patent does not provide numerical values for the spacing between contacts 12 and 13 in Figure 2A or specify the value of the fringe-effect capacitance formed.

23. According to the laws of physics, fringe-effect capacitance is always present wherever two electrical conductors are positioned in an edge-to-edge relationship.

24. The capacitor shown in Figure 2A of the '356 patent is prior art to the asserted claims.

25. A combination of several variables other than the gap width also affects the resulting fringe-effect capacitance between contacts 12 and 13. These variables include the thicknesses (T), lengths (L), and widths (W) of the contacts 12 and 13, and the dielectric constant (ε_r) of the dielectric material.

26. An accepted formula for calculating fringe-effect capacitance, C_{FE}, is $\pi\varepsilon_r\varepsilon_o L/2\ln[(\pi(D-W)/(W+T) + 1)]$, where T is the thickness, L is the length, and W is the width of each contact, and D is the distance between the center points of the contacts. As shown below, the gap width (g) is equal to (D-W). The variable ε_r is the relative permittivity of the dielectric material, also called its dielectric constant, and ε_o is the permittivity of air. (Dougherty n. 4, Ex. F; Tr. 236:1-13.)



27. The '356 patent specification does not provide any numerical values of the thicknesses T, lengths L, or widths W of contacts 12 and 13, or dielectric constants ε_r for the dielectric materials, for any of the capacitors shown in the figures or described in the specification of the '356 patent.

28. Even capacitors having the same gap width between first and second contacts as shown above in paragraph 26 can have different fringe-effect capacitances between the contacts.

"First" Fringe-Effect Capacitance

29. The '356 patent specification does not disclose any criteria for determining which fringe-effect capacitance within a capacitor is the "first" as claimed in claim 1.

Dependent Claims 2-5, 16, 18, and 19

30. None of dependent claims 2-5, 16, 18, and 19 further define or limit the meaning of "substantially monolithic" or "sufficiently close" as claimed in claim 1.

Claim 3: "Sufficiently Close"

31. In claim 3, the term "sufficiently close" has the same meaning as "sufficiently close" in claim 1.

Claim 18: "The Ceramic Body"

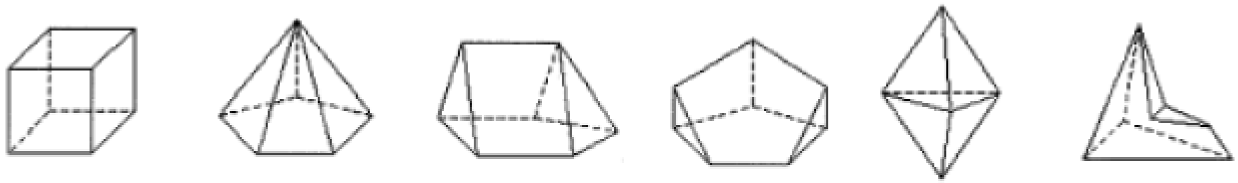
32. There is no prior recitation of "*a* ceramic body" in claim 1 or claim 18 to introduce the claim term "*the* ceramic body" in claim 18.

33. Each of the capacitor structures shown in Figures 8A and 8B of the '356 patent have two dielectric bodies.

Claim 19: "Hexahedron Shape"

34. The specification and prosecution history of the '356 patent provide no definition for hexahedron shape.

35. All of the objects shown below are hexahedrons:



36. The term "hexahedron" encompasses any three-dimensional object having six (and only six) sides.

37. The term "hexahedron" does not define a shape.

38. The term "hexahedron shape" in claim 19 is a requirement of the dielectric body, not the capacitor as a whole.

Dated: June 11, 2008 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C.

By: /s/ Timur Slonim

Daniel T. Pascucci, Esq.
dpascucci@mintz.com
Nathan R. Hamler, Esq.
nhamler@mintz.com
Marvin S. Gittes, Esq. (*pro hac vice*)
mgittes@mintz.com
Timur E. Slonim, Esq. (*pro hac vice*)
tslonim@mintz.com
Peter F. Snell, Esq. (*pro hac vice*)
psnell@mintz.com
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C.
666 Third Avenue
New York, NY 10017
Telephone: (212) 692-6800
Facsimile: (212) 983-3115

CERTIFICATE OF SERVICE

I, the undersigned, certify and declare that I am over the age of 18 years, employed in the County of New York, State of New York, and am not a party to the above-entitled action.

On June 11, 2008, I filed and served a copy of the following document(s):

ATC'S STATEMENT OF UNDISPUTED MATERIAL FACTS IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT OF INDEFINITENESS

by electronically filing the foregoing with the Clerk of the Court using the CM/ECF system which will send notification of such filing to the following:

Miles D. Grant, Esq. Grant & Zeko, APC 1331 India Street San Diego, CA 92101	Attorneys for Plaintiff/Counter-Defendant PRESIDIO COMPONENTS, INC. Email: mgrant@grantandzeko.com
Gregory F. Ahrens, Esq. Wood Herron and Evans 441 Vine Street 2700 Carew Tower Cincinnati, OH 45202	Attorneys for Plaintiff/Counter-Defendant PRESIDIO COMPONENTS, INC. Email: gahrens@whepatent.com
Brett A. Schatz, Esq. Wood Herron and Evans 441 Vine Street Carew Tower Cincinnati, OH 45202	Attorneys for Plaintiff/Counter-Defendant PRESIDIO COMPONENTS, INC. Email: bschatz@whepatent.com

Executed on June 11, 2008, at New York, New York.

/s/ Timur Slonim
Timur Slonim